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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/812,394	03/30/2004	Prashant Fuloria	16113-640001-GP-227-00-US	1742
26192	7590	05/13/2009		
FISH & RICHARDSON P.C. PO BOX 1022 MINNEAPOLIS, MN 55440-1022			EXAMINER BROWN, ALVIN L	
			ART UNIT 3622	PAPER NUMBER
			NOTIFICATION DATE 05/13/2009	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PATDOCTC@fr.com

Office Action Summary

Application No.

10/812,394

Applicant(s)

FULORIA ET AL.

Examiner

ALVIN L. BROWN

Art Unit

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 March 2004.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-82 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-82 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 30 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date 12/06/2005; 11/28/2005
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

1. The following is a non-final, First Office Action on the merits. Claims 1- 82 are pending.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 1-22, 29-34, 41-51, 58-62, 64-72, and 82 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Based on Supreme Court precedent, a method/process claim must (1) tied to a particular machine or apparatus (see at least *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing (see at least *Gottschalk v. Benson*, 409 U.S. 63, 71 (1972)). A method/process claim that fails to meet one of the above requirements is not in compliance with the statutory requirements of 35 U.S.C. 101 for patent eligible subject matter. Here the claims fails to meet the above requirements because the steps are neither tied to another statutory class of invention (such as a particular apparatus) nor physically transform underlying subject matter (such as an article or materials) to a different state or thing.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 3-5, 9, 13, 15, 17-23, 27-29, 31-35, 37-42, 44, 46-47, 49-51, 53-54, 56-57, 61-64, 66, 68-70, 73-80, 82 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gerace (5,848,396, hereinafter Gerace) in view of Swix et al., (2004/0163101 hereinafter Swix).

As per claims 1, 29, 63-64, 73, 82, Gerace discloses a method for selectively delivering legal information communications for documents, comprising the steps of:

identifying a location of the user associated with the input (column 10, line 53 – column 11, line 4);

determining whether to utilize a legal information communication based at least in part on the location (column 8, line 52 – column 9, line 7); and

delivering at least one document based at least in part on the input, wherein the at least one document is delivered with a legal information communication if the location is determined to be in a legal information communication jurisdiction (column 8, line 52 – column 9, line 7 where weather warnings are interpreted as legal information based on region or location using the broadest reasonable interpretation).

Gerace does not explicitly disclose receiving an input, wherein the input is a document-triggering event operative to cause a document to be delivered to a user.

However, Swix discloses receiving an input, wherein the input is a document-triggering event operative to cause a document to be delivered to a user (paragraph [0013]).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to add Swix's document delivered to a user to Gerace's

legal information based on location. One would be motivated to do this in order to provide improved targeted content to customers regardless of location.

As per claim 3, Swix further discloses the input is a search query from a user (paragraph [0013]).

As per claim 4, Gerace further discloses the input comprises a concept associated with at least one targeted advertisement, and further comprising the steps of: associating a concept with the at least one targeted advertisement; and selecting the at least one targeted advertisement for delivery to a user in response to the input, wherein the concept is associated with the input (column 4, line 30-35).

As per claim 5, Gerace further discloses the input comprises a request for an advertisement associated with one or more concepts, and wherein the advertisement is a targeted advertisement associated with the one or more concepts (column 4, line 30-35).

As per claim 9, Swix further discloses the receiving, identifying, determining, and delivering steps are performed automatically (paragraph [0013]).

As per claim 13, Swix further discloses the action of: approving the advertisement for trademark usage (paragraph [0007]).

As per claim 15, Gerace further discloses the determining action comprises identifying the country where the source is located (column 21, lines 40-49).

As per claims 17, 26, 31, 37, 44, 56, Gerace further discloses the content page comprises one or more of a web page, email and print media (column 1, lines 29-44).

As per claims 18, 28, 33, 39, 50, Gerace further discloses the advertisement comprises one or more of an image, animation, pop-up ability, sound, voice and music (column 12, lines 42-56).

As per claim 19, Gerace further discloses determining whether to provide a legal information communication is further based at least in part on whether the targeted advertisement is a comparative ad (column 34, lines 7-15).

As per claim 20, 24, 34, 40, 51, 53, 66, 75, Gerace further discloses the document is an advertisement (column 8, line 52 – column 9, line 30).

As per claim 21, Gerace further discloses the document is a targeted advertisement of an advertiser, wherein the targeted advertisement was associated with a concept by the advertiser, and wherein the targeted advertisement is selected to be delivered based at least in part on its association with the concept Column 4, lines 30-35).

As per claim 22, Gerace further discloses the concept is at least one of one or more subject matters, one or more locations in semantic space, and one or more key words (column 22, lines 57-65).

As per claim 23 and 35, Gerace discloses a system for selectively providing legal information communications in documents, comprising:

a server that receives input and delivers documents based at least in part on the input to a location, wherein the server utilizes a trademark legal information communication if the location is in a legal information communication jurisdiction (figure 1; column 8, line 52 – column 9, line 7).

an identification module that identifies the location (column 10, line 53—column 11, line 4); and

a processor that determines whether the location is in a legal information communication jurisdiction (figure 2).

As per claims 27, 38, 42, 54, Swix further discloses the input comprises a search query by a user (paragraph [0013]).

As per claim 32, Swix further discloses the concept comprises at least one or more keywords entered as a search request (paragraph [0013]).

As per claim 41, Gerace discloses a method for selectively delivering documents, comprising: receiving a request for a document associated with a concept (column 4, lines 30-35). Swix further discloses determining whether the concept is identified with a trademark (paragraph [0007]); and determining whether to deliver the document based at least in part on whether the concept is identified with a trademark (paragraph [0007]).

As per claims 46, Gerace further discloses the action of determining whether the location is in a legal information communication jurisdiction responsive to a determination that the concept is identified with a trademark (column 8, line 52- column 9, line 7).

As per claim 47, Gerace further discloses the action of delivering the document with a legal information communication responsive to a determination that the location is in a legal information communication jurisdiction (column 8, line 52- column 9, line 7).

As per claims 49, 57, Gerace further discloses the actions of:

responsive to a determination that the concept is not identified with a trademark:
identifying the location of a user (column 10, line 53 – column 11, line 4);
determining whether to provide a legal information communication based at least in part on the location (column 8, line 52 – column 9, line 7); and
delivering at least one document to the user based at least in part on the input, wherein the at least one document is delivered with a legal information communication if the location is determined to be in a legal information communication jurisdiction (column 8, line 52 – column 9, line 7).

As per claim 61, Gerace further discloses the actions of: receiving a request for an advertisement associated with the concept; and delivering the advertisement (column 4, lines 30-35).

As per claim 62, Gerace discloses a method of receiving documents, comprising: transmitting input from a location; receiving a response comprising one or more documents, wherein the one or more documents are selected based at least in part on the input (column 4, line 30-35); and

receiving a legal information communication if the location is determined to be in a legal information communication jurisdiction (column 8, line 52 - column 9, line 7).

As per claim 68, Gerace further discloses the determining action is based in part on the location of the requesting system (column 10, line 53- column 11, line 4).

As per claim 69, Gerace further discloses the determining action is based in part on the location of a user to whom the requesting system delivers the document (column 10, line 53- column 11, line 4).

As per claim 70, Gerace further discloses determining action is based in part on a location factor (column 10, line 53- column 11, line 4).

As per claim 74, Gerace further discloses the acceptance level indicates the requesting system's willingness to accept documents associated with trademark-related concepts(column 10, line 53- column 11, line 4).

As per claim 76, Gerace further discloses the determination means determines whether to include a legal information communication with the document based in part on the acceptance level for trademark usage (column 10, line 53- column 11, line 4)...

As per claim 77, Gerace further discloses the determination means determines whether to deliver the one or more documents based in part on the location of the requesting system (column 8, line 52-column 9, line 7).

As per claim 78, Gerace further discloses the determination means determines whether to deliver the one or more documents based in part on the location of a user to whom the requesting system delivers the document (column 8, line 52-column 9, line 7).

As per claim 79, Gerace further discloses the determination means determines whether to deliver the one or more documents based in part on a location factor (column 8, line 52-column 9, line 7).

As per claim 80, Gerace further discloses the determination means determines whether to deliver the one or more documents based at least in part on a trademark usage level set for the location (column 8, line 52-column 9, line 7).

6. Claims 2, 10, 45, 48, 52, 60, 65, 67, 71-72, 81 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gerace in view of Swix, further in view of The

New York Post, Amazon Picks a fight with Old Gray Lady, June 5, 1999, page 17, (hereinafter NY Post).

As per claim 2, the Gerace and Swix combination discloses the claim limitation as in claim 1. The combination does not explicitly disclose the legal information communication comprises a disclaimer.

However, NY Post discloses a legal information communication comprises a disclaimer (page 17).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to add NY Post's disclaimer to the combination's legal information communication. One would be motivated to do this in order to better inform customers of the identify of advertisers on a particular website.

As per claims 10 and 45, NY Post further discloses the legal information communication indicates that the at least one targeted advertisement might not be sponsored by any trademark holder (page 17).

As per claim 48, NY Post further discloses the action of delivering the document responsive to a determination that the concept is not in a legal information communication jurisdiction (page 17).

As per claim 52, Gerace discloses a system for selectively approving documents for association with a concept, comprising:

a server that receives a request to associate a document with a concept (column 8, line 52 – column 9, line 7). NY Post further discloses a processor that determines whether the concept is identified with a trademark, wherein the processor is further

configured to deny the request responsive to a determination that the concept is identified with a trademark (page 17).

As per claim 60, NY Post further discloses the action of indicating that the advertisement is a comparative advertisement responsive to a determination that the concept is a trademark not owned by the advertiser (page 17).

As per claim 65, NY Post further discloses the acceptance level indicates the requesting system's willingness to accept documents associated with trademark-related concepts (page 17).

As per claim 67, NY Post further discloses the action of determining whether to include a legal information communication with the document based in part on the acceptance level for trademark usage (page 17).

As per claim 71, NY Post further discloses the determining action uses the more restrictive trademark usage level between the location-based level and the receiving system's acceptance level (page 17).

As per claim 72, NY Post further discloses the determining action uses the more restrictive trademark usage level between the location-based level and the receiving system's acceptance level (page 17).

As per claim 81, NY Post further discloses the determination means determines whether to deliver the one or more documents based the determining action using the more restrictive trademark usage level between the location-based level and the receiving system's acceptance level (page 17).

7. Claims 6-8, 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gerace in view of Swix, further in view of Gutierrez-Sheris (20080033870 herein after Gutierrez).

As per claim 6, the Gerace and Swix combination discloses the claimed invention as in claim 1. The combination does not explicitly disclose the legal information communication comprises an acknowledgment request.

However, Gutierrez discloses legal information communication comprises an acknowledgment request (paragraph [0128]).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to add Gutierrez's user acknowledgement of information to the combination's legal information communication. One would be motivated to do this in order to improve communication with customer in order for the customer to make better informed decisions.

As per claim 7, Gutierrez further discloses the action of receiving response to the acknowledgment (paragraph [0128]).

As per claim 8, Gutierrez further discloses the response is received prior to displaying the document to the user (paragraph [0128]).

As per claim 14, Gutierrez further discloses the determining action comprises identifying the Internet protocol address of the source (paragraph [0131]).

8. Claims 11, 16, 25, 30, 36, 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gerace in view of Swix, further in view of Llach (20040186776 herein after Llach).

As per claim 11, the Gerace and Swix combination discloses the claimed invention as in claim 1. The combination does not explicitly disclose the targeted advertisement is positioned for display based at least in part on a ranking among advertisements for the concept, the ranking being based at least on a price parameter amount.

However, Llach discloses a targeted advertisement is positioned for display based at least in part on a ranking among advertisements for the concept, the ranking being based at least on a price parameter amount (paragraph [0008]).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to add Llach's ranking method to the combination's legal information communication. One would be motivated to do this in order to improve the method in which advertisements are targeted to the consumer.

As per claims 16, 25, 30, 36, 43, Llach further discloses the targeted advertisement is displayed on one or more of a content page and a search result page (paragraphs [0022, 0026]).

9. **Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gerace in view of Swix further in view of Official Notice.**

As per claim 12, the Gerace and Swix combination discloses the claimed invention as in claim 1. The combination does not explicitly disclose approving the advertisement for display for offensive material and for relevancy to the concept with which the advertisement has been associated.

Official Notice is taken that it is old and well known to approve the advertisement graphics for display of offensive material automatically as done by search engines such as www.onekey.com and ah-ha.com, since this enables the filtering of search content for children and prevents them from accessing potentially harmful information on the Internet while still giving them access to the wealth of information that is available on the Internet.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to add the steps of reviewing and approving the advertisement graphics for display for offensive material automatically to the combination's legal information communication. One would be motivated to do this in order to ensure that customers gain access to information that is safe and targeted to them.

10. Claims 58-59 are rejected under 35 U.S.C. 103(a) as being unpatentable over NY Post, in view of Krause et al., (20030204813).

As per claim 58, NY Post discloses a method for providing targeted advertisements, comprising the steps of:

processing the database to determine whether the concept is identified with a trademark not owned by the advertiser (page 17);

responsive to a determination that the concept is identified with a trademark not owned by the advertiser, denying the request (page 17); and

responsive to a determination that the concept is not identified with a trademark not owned by the advertiser, associating the advertisement with the concept (page 17).

NY Post does not explicitly disclose storing a list of trademarks and trademark owners in a database; receiving from an advertiser a request to associate an advertisement with a concept.

However, Krause discloses storing a list of trademarks and trademark owners in a database; receiving from an advertiser a request to associate an advertisement with a concept (paragraphs [0048, 0060]).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to add Krause's storing a list of trademarks in a database to the combination's legal information communication. One would be motivated to do this in order to improve the method in which advertisements are targeted to the consumer.

As per claim 59, Krause further discloses the list comprises a list of registered trademarks in at least one jurisdiction (paragraphs [0048, 0060]).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ALVIN L. BROWN whose telephone number is (571)270-5109. The examiner can normally be reached on Monday - Thursday 7:30 AM to 5:00 PM Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on 571 272 6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

ALB

/Arthur Duran/

Primary Examiner, Art Unit 3622